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09/327,085	06/04/1999	JOSEPH BACH		5016

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EXAMINER

VIG, NARESH

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3629

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/327,085
Filing Date: June 04, 1999
Appellant(s): BACH, JOSEPH

Joseph Bach (Registration No. 37,771)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09 March 2006 appealing from the Office action mailed 15 December 2005.

(1) Real Party In Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(5) Summary of Claimed Subject Matter

Appellant has not indicated where every element in claim 1 could be found in the spec. For example:

“a main processor receiving a programming signal and a rider signal from a program transmission channel and directing said programming signal to the audio player and storing the rider signal in the rider buffer”;

“ordering interrupter instructs the communication device to establish communication with an ordering center via said telephone, and places an order for a hard copy of the music piece corresponding to the data stored in said rider buffer”.

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(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,389,055	August et al.	5-2002
5,303,393	Noreen et al.	4-1994

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 4 are unpatentable under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added). Appellant's claims mentioned above are intended to embrace or overlap *two* different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing an interactive audio system (ex. preamble of claim 1), the body of the claim discusses the specifics of method (the steps) executed by the interactive audio system. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 5 and 6 are unpatentable under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention. Appellant claim is directed to interactive audio system claim, however, body of the claim discusses the specifics of method (the steps) executed by the interactive audio system.

Claim Rejections - 35 USC § 103

Claims 1, 2, 5 and 6 are unpatentable under 35 USC 103(a) over August et al. US Patent 6,389,055 in view of Noreen et al. US Patent 5,303, 393.

Regarding claim 1, August teaches an interactive audio system (system and method for initiating a transaction using the wireless capture of information obtained from a video/audio device, and, more particularly from an audio device such as a radio in a car or home premises).

August does not explicitly teaches a home audio system having a user interface. However, August teaches display device [Fig. 6 and disclosure associated with Fig. 6]; Noreen teaches interface means to communicates the program signal to a user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify August as taught by August to communicate information to user [Noreen, col. 2, lines 45 – 53].

August in view of Noreen teaches:

a communication device for connecting said home audio system to a telephone [August, Fig. 5 and disclosure associated with Fig. 5];

an audio player for receiving music signal and audibly playing music pieces from said music signal [August, Fig. 1 and disclosure associated with Fig. 1];

a rider buffer for storing data corresponding to said music pieces; However, August teaches to allow user to purchase one of the items advertised, or order catalogs

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automatically, viewer simply presses the DIAL button, launching a telephone call, and then presses the SEND DATA button, sending captured data such as product information (obvious that rider/purchase data is stored), to an agent [August, Fig. 8 and disclosure associated with Fig. 8];

a main processor receiving a programming signal and a rider signal from a program transmission channel and directing said programming signal to the audio player and storing the rider signal in the rider buffer [Fig. 6 & 8, and disclosure associated with Fig. 6 & 8];

an ordering interrupter [Noreen, col. 2, line 48];

wherein upon receiving a command from the user interface, said ordering interrupter instructs the communication device to establish communication with an ordering center via said telephone, and places an order [August, Fig. 8 and disclosure associated with Fig. 8] for a hard copy of the music piece corresponding to the data stored in said rider buffer (purchasing of product as taught by August and Noreen).

Regarding claim 2, August in view of Noreen teaches ordering memory having ordering data stored therein (sending captured data, such as product information, to an agent, who can verify the order using the additional information that was captured or stored in the device) [August, Fig. 8 and disclosure associated with Fig. 8].

Regarding claim 5, August in view of Noreen teaches communication device comprises a cellular phone [August, Fig. 4 and disclosure associated with Fig. 4].

Regarding claim 6, August in view of Noreen teaches communication device comprises a modem [August, Fig. 6 and disclosure associated with Fig. 6].

(10) Response to Argument

Appellant is separating the cited reference to make the arguments in this appeal brief. Appellant is not considering cited reference August in view of Noreen to make the arguments.

In response to appellant's argument that rejection for claims 1, 2, 5 and 6 under 35 USC 101 and 35 USC 112 are improper because Claim 1 is clearly directed at an apparatus and no method or steps are recited therein.

However, rejection for claims 1, 2, 5 and 6 under 35 USC 101 and 35 USC 112 are proper because appellant clearly recites the method steps in a system claim. In claim 1, limitation 5, Appellant recites "a main processor receiving a program signal and a rider signal from a program transmission channel and directing said programming to the audio player and storing the rider signal in the rider buffer" which shows that the main process is performing tasks like directing programming signal received from transmission channel to the audio player and storing the rider signal in the rider buffer.

In response to appellant's argument that cited reference August teaches not to separate the rider signal from the program signal prior to providing the audio signal.

However, appellant is arguing a limitation of separating the two signals which is not claimed by the appellant.

In response to appellant's argument that cited reference August teaches the use of a conventional (unmodified) audio/video device (monitors 10 and 105) to reproduce the incoming program and data signals as combined audio signal 20.

However, August Fig. 5 and disclosure associated with Fig. 5 teaches an Audio/Video device (101) which receives signal 103, and transfers nondiscernable visual pattern to a capture device (110) which is capable for storing the data for later use [August, col. 5, line 52 – col. 6 line 15].

In response to appellant's argument that cited reference August fails to disclose or suggest the limitation "a main processor receiving a programming signal and a rider signal from a program transmission channel and directing said programming signal to the audio player and storing the rider signal in the rider buffer"

However, Appellant's Fig. 3 and 5 originally filed 04 June 1999 show receiving of only a single transmission, and cited reference August Fig. 5 also shows receiving single transmission (August Fig. 5 (103)). August Fig. 5 and disclosure associated with Fig. 5 teaches the limitation "a main processor (August 101) receiving a programming signal and a rider signal (August 103) and directing said programming signal to the

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audio player (August 105) and storing the rider signal in the rider buffer (August 110)" [August, col. 5, line 52 – col. 6 line 15].

In response to appellant's argument that in cited reference August, for example, a receiver, such as a radio or a television, receives the program signal and the rider signal and plays both signals. 'the receiver does not separate the signals, does not store the rider signal in a rider buffer - nor is there a suggestion or a motivation to do so.

However, appellant had not claimed the limitation of the system having a main processor for separating the combined signals received prior to directing only the programming signal to the audio player, and filtering out the rider signal for storing it in the rider buffer. Teaching of cited references having means for storing rider signal has been responded earlier.

In response to appellant's argument that even in cited reference August the programming signal has already been played and perceived by the user. Again, the Examiner failed to provide any indication as to how August combined with Noreen make this limitation obvious.

However, as responded to earlier Appellant's Fig. 3 and 5 originally filed 04 June 1999 show receiving of only a single transmission, and cited reference August Fig. 5 also shows receiving single transmission (August Fig. 5 (103). August Fig. 5 and disclosure associated with Fig. 5 teaches the limitation "a main processor (August 101) receiving a programming signal and a rider signal (August 103) and directing said

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programming signal to the audio player (August 105) and storing the rider signal in the rider buffer (August 110)" [August, col. 5, line 52 – col. 6 line 15] which clearly demonstrates that cited reference has means of separating signals and only playing the programming signals on the audio device (i.e. programming signal is separated prior to playing on audio device).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Naresh Vig
Examiner
AU 3629

Conferees:

Tan Dean Nguyen



John Weiss

